

ESTTA Tracking number: **ESTTA614007**

Filing date: **07/07/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	SmartFocus UK Ltd.		
Entity	Corporation	Citizenship	United Kingdom
Address	Lynton House 7-12 Tavistock Square London, WC1H 9LT UNITED KINGDOM		

Attorney information	David M. Kelly Kelly IP, LLP 1330 Connecticut Avenue, N.W. Suite 300 Washington, DC 20036 UNITED STATES david.kelly@kelly-ip.com, docketing@kelly-ip.com, larry.white@kelly-ip.com
----------------------	---

Registration Subject to Cancellation

Registration No	2089097	Registration date	08/19/1997
Registrant	AFFINITAS CORPORATION 1015 NORTH 98TH STREET OMAHA, NE 68114 UNITED STATES		

Goods/Services Subject to Cancellation

Class 035. First Use: 1996/02/28 First Use In Commerce: 1996/02/28
All goods and services in the class are cancelled, namely: broad based market segmentation analysis services allowing marketers to understand their markets in more detail

Grounds for Cancellation

Abandonment	Trademark Act section 14
-------------	--------------------------

Attachments	FINAL Petition for Cancellation against SMARTFOCUS (U S Reg No 2089097) (330799xD1162).pdf(310460 bytes)
-------------	---

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/David M. Kelly/
Name	David M. Kelly

Date	07/07/2014
------	------------

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

SMARTFOCUS UK LTD., Petitioner v. AFFINITAS CORPORATION, Respondent.	Cancellation No.: Mark: SMARTFOCUS Reg. No. 2089097 Issued: August 19, 1997
--	--

PETITION FOR CANCELLATION

SmartFocus UK Ltd. (“Petitioner”) believes that it is being damaged by the registration of Affinitas Corporation’s (“Respondent”) mark SMARTFOCUS shown in U.S. Registration No. 2089097 (“Respondent’s Registration”) and petitions to cancel the same. As grounds for its cancellation, Petitioner alleges that, upon actual knowledge with respect to itself and its own acts, and upon information and belief as to other matters:

Petitioner and its SMARTFOCUS Mark

1. Petitioner is a United Kingdom corporation with its principal place of business at Lynton House 7-12 Tavistock Square, London, United Kingdom WC1H 9LT.
2. Petitioner is a cloud marketing platform provider.
3. Petitioner owns U.S. Application No. 85897968, filed on April 8, 2013 under Sections 1(b) and 44(d), for the mark SMARTFOCUS for “computer software for use in creating, distributing, personalizing and managing electronic communications relating to marketing campaigns and analyzing the results of same; downloadable software in the nature of a computer program and /or mobile application for creating,

distributing, personalizing and managing marketing and social media campaigns and to help analyze the results of same” in International Class 9, “data processing management; customer relationship marketing intelligence management; social media marketing consultancy; research into consumer buying habits, patterns and trends; research into consumer buying motivation; media planning being media marketing and advertising strategy; marketing and advertising media analysis services; market research; advertising by mail order; compilation of direct mailing lists; compilation of mailing lists; direct mail advertising; marketing by mail; preparation of mailing lists; preparation of mailing lists for direct mail advertising services; direct marketing, database marketing; telemarketing; business statistical analysis and reporting; processing and analysis of business statistics; database management; business information services; business consulting services in the field of electronic commerce; advertising and marketing management; agency services, namely, the creation, development and dissemination of advertising and promotional materials via direct mail, newspaper, radio, television, mobile electronic devices, a global computer network and other interactive media; consulting services, namely, interception and market analysis of advertising enquiries for the businesses of others; marketing consulting; consulting and computerised database management services for the businesses of others, namely, interpretation of market data analysis and management of advertising response data; analysis of data responses and market conditions to identify customers and define prospects; preparing personalised needs analysis, metrics, reports and recommendations for advertising, marketing and retail; customer relationship management services featuring prospect and customer qualification, communication, cultivation, retention and management; business research services and information

services relating to all the aforesaid” in International Class 35, “communication by computers; electronic transmission of data, messages and images via computer terminals, electronic tablets, mobile phones; broadcast communication transmission of messages using digital interactive services; streaming of digital content via the Internet” in International Class 38, “education services, namely, online and in-person seminars, conferences, and training in the field of marketing; publishing services; provision of online non-downloadable electronic publications in the field of marketing” in International Class 41, and “design research in the field of graphic arts; graphic design illustrating services; industrial and commercial art design services; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; computer services, namely, designing and implementing network web sites, software applications and information technology computer network systems for others; website design services; creation, editing and updating of website content; software development and maintenance of computer programs and mobile applications to track consumer usage and preferences on websites; design of publicity and advertising materials; computer services, namely, designing and implementing banner advertisements on internet sites for others; graphic design services” in International Class 42 (“Application”). TESS and TSDR Printouts from the PTO is attached as Exhibit A.

4. On August 2, 2013, the U.S. Patent and Trademark Office (“PTO”) issued an Office Action and refused to register Petitioner’s SMARTFOCUS mark based on a likelihood of confusion with Respondent’s Registration, among others.

5. On February 3, 2014, Petitioner filed a Response to Office Action amending the description of services under the Application to further clarify its offerings and avoid a likelihood of confusion with Respondent’s Registration.

6. On March 3, 2014, the PTO suspended the Application and maintained its likelihood of confusion refusal with respect to Respondent's Registration.

Respondent and its SMARTFOCUS Mark

7. Respondent is a Nebraska corporation with its principal place of business at 2949 North 27th Street, Suite 101, Lincoln, Nebraska 68521-1430.

8. Respondent is the listed owner for U.S. Registration No. 2089097, issued on August 19, 1997, for the mark SMARTFOCUS for "broad based market segmentation analysis services allowing marketers to understand their markets in more detail" in International Class 35, alleging a date of first use in commerce of February 28, 1996.

Abandonment Under Section 45, 15 U.S.C. § 1127

9. Petitioner repeats and realleges each and every allegation set forth in Paragraphs 1 through 8.

10. Upon information and belief, Respondent has abandoned the SMARTFOCUS mark shown in U.S. Registration No. 2089097 based on non-use in commerce for at least three consecutive years in connection with "broad based market segmentation analysis services allowing marketers to understand their markets in more detail," and with an intent not to commence or resume use of the mark in connection with such services.

11. Accordingly, U.S. Registration No. 2089097 for the SMARTFOCUS mark should be cancelled in its entirety based on abandonment of the mark under Section 45 of the Lanham Act, 15 U.S.C. § 1127.

WHEREFORE, Petitioner believes that it is being and will continue to be damaged by the registration of the mark SMARTFOCUS shown in U.S. Registration No. 2089097, and requests that the Petition for Cancellation be sustained, and that the registration be cancelled.

A filing fee has been submitted electronically. Any deficiency in the fee should be charged to Deposit Account No. 506154.

Respectfully submitted,

SMARTFOCUS UK LTD.

Dated: July 7, 2014

By: David M. Kelly/

David M. Kelly
david.kelly@kelly-ip.com
Radiance W. Harris
radiance.harris@kelly-ip.com
Kelly IP, LLP
1330 Connecticut Ave., NW, Suite 300
Washington, D.C. 20036
Telephone: 202-808-3570
Facsimile: 202-354-5232
Attorneys for Petitioner

CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing **PETITION FOR CANCELLATION** was served by first class mail, postage prepaid, on July 7, 2014, upon Respondent and counsel for Respondent at the correspondence addresses of record below:

Affinitas Corporation
1015 North 98th Street
Omaha, Nebraska 68114

Denise C. Mazour
McGrath North
1601 Dodge St., Suite 3700
Omaha, NEBRASKA 68102

/Larry L. White/
Larry L. White
Litigation Case Manager

Exhibit A



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)

Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Mon Jul 7 03:20:34 EDT 2014

[TESS HOME](#) [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [BROWSE DICT](#) [SEARCH OG](#) [BOTTOM](#) [HELP](#)[Logout](#)

Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

[TSDR](#)[ASSIGN Status](#)[TTAB Status](#)

(Use the "Back" button of the Internet Browser to return to TESS)

SMARTFOCUS

Word Mark SMARTFOCUS

Goods and Services

IC 009. US 021 023 026 036 038. G & S: Computer software for use in creating, distributing, personalizing and managing electronic communications relating to marketing campaigns and analyzing the results of same; downloadable software in the nature of a computer program and /or mobile application for creating, distributing, personalizing and managing marketing and social media campaigns and to help analyze the results of same

IC 035. US 100 101 102. G & S: Data processing management; customer relationship marketing intelligence management; social media marketing consultancy; research into consumer buying habits, patterns and trends; research into consumer buying motivation; media planning being media marketing and advertising strategy; marketing and advertising media analysis services; market research; advertising by mail order; compilation of direct mailing lists; compilation of mailing lists; direct mail advertising; marketing by mail; preparation of mailing lists; preparation of mailing lists for direct mail advertising services; direct marketing, database marketing; telemarketing; business statistical analysis and reporting; processing and analysis of business statistics; database management; business information services; business consulting services in the field of electronic commerce; advertising and marketing management; agency services, namely, the creation, development and dissemination of advertising and promotional materials via direct mail, newspaper, radio, television, mobile electronic devices, a global computer network and other interactive media; consulting services, namely, interception and market analysis of advertising enquiries for the businesses of others; marketing consulting; consulting and computerised database management services for the businesses of others, namely, interpretation of market data analysis and management of advertising response data; analysis of data responses and market conditions to identify customers and define prospects; preparing personalised needs analysis, metrics, reports and recommendations for advertising, marketing and retail; customer relationship management services featuring prospect and customer qualification, communication, cultivation, retention and management; business research services and information services relating to all the aforesaid

IC 038. US 100 101 104. G & S: Communication by computers; electronic transmission of data, messages and images via computer terminals, electronic tablets, mobile phones; broadcast communication transmission of messages using digital interactive services; streaming of digital content via the Internet

IC 041. US 100 101 107. G & S: Education services, namely, online and in-person seminars, conferences, and training in the field of marketing; publishing services; provision of online non-downloadable electronic publications in the field of marketing

IC 042. US 100 101. G & S: Design research in the field of graphic arts; graphic design illustrating services; industrial and commercial art design services; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; computer services, namely, designing and implementing network web sites, software applications and information technology computer network systems for others; website design services; creation, editing and updating of website content; software development and maintenance of computer programs and mobile applications to track consumer usage and preferences on websites; design of publicity and advertising materials; computer services, namely, designing and implementing banner advertisements on internet sites for others; graphic design services

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 85897968

Filing Date April 8, 2013

Current Basis 1B;44D

Original Filing Basis 1B;44D

Owner (APPLICANT) SMARTFOCUS UK LTD CORPORATION UNITED KINGDOM LYNTON HOUSE 7-12 TAVISTOCK SQUARE LONDON UNITED KINGDOM WC1H 9LT

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record David M. Kelly

Priority Date March 21, 2013

Type of Mark TRADEMARK. SERVICE MARK

Register PRINCIPAL

Live/Dead Indicator LIVE

[TESS HOME](#)[NEW USER](#)[STRUCTURED](#)[FREE FORM](#)[BROWSE DICT](#)[SEARCH OG](#)[TOP](#)[HELP](#)

[|.HOME](#) | [SITE INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [HELP](#) | [PRIVACY POLICY](#)

Generated on: This page was generated by TSDR on 2014-07-03 14:51:30 EDT

Mark: SMARTFOCUS

SMARTFOCUS

US Serial Number: 85897968

Application Filing Date: Apr. 08, 2013

Register: Principal

Mark Type: Trademark, Service Mark

Status: An Office action suspending further action on the application has been sent (issued) to the applicant. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Mar. 03, 2014

Mark Information

Mark Literal Elements: SMARTFOCUS

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Foreign Information

Priority Claimed: Yes

Foreign Application Number: 011677192

Foreign Application Filing Date: Mar. 21, 2013

Foreign Application/Registration Country: EUROPEAN (EU) OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET (OHIM)

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks "*" identify additional (new) wording in the goods/services.

For: Computer software for use in creating, distributing, personalizing and managing electronic communications relating to marketing campaigns and analyzing the results of same; downloadable software in the nature of a computer program and /or mobile application for creating, distributing, personalizing and managing marketing and social media campaigns and to help analyze the results of same

International Class(es): 009 - Primary Class

U.S Class(es): 021, 023, 026, 036, 038

Class Status: ACTIVE

Basis: 1(b) 44(d)

For: Data processing management; customer relationship marketing intelligence management; social media marketing consultancy; research into consumer buying habits, patterns and trends; research into consumer buying motivation; media planning being media marketing and advertising strategy; marketing and advertising media analysis services; market research; advertising by mail order; compilation of direct mailing lists; compilation of mailing lists; direct mail advertising; marketing by mail; preparation of mailing lists; preparation of mailing lists for direct mail advertising services; direct marketing, database marketing; telemarketing; business statistical analysis and reporting; processing and analysis of business statistics; database management; business information services; business consulting services in the field of electronic commerce; advertising and marketing management; agency services, namely, the creation, development and dissemination of advertising and promotional materials via direct mail, newspaper, radio, television, mobile electronic devices, a global computer network and other interactive media; consulting services, namely, interception and market analysis of advertising enquiries for the businesses of others; marketing consulting; consulting and computerised database management services for the businesses of others, namely, interpretation of market data analysis and management of advertising response data; analysis of data responses and market conditions to identify customers and define prospects; preparing personalised needs analysis, metrics, reports and recommendations for advertising, marketing and retail; customer relationship management services featuring prospect and customer qualification, communication, cultivation, retention and management; business research services and information services relating to all the aforesaid

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 1(b) 44(d)

For: Communication by computers; electronic transmission of data, messages and images via computer terminals, electronic tablets, mobile phones; broadcast communication transmission of messages using digital interactive services; streaming of digital content via the Internet

International Class(es): 038 - Primary Class

U.S Class(es): 100, 101, 104

Class Status: ACTIVE

Basis: 1(b) 44(d)

For: Education services, namely, online and in-person seminars, conferences, and training in the field of marketing; publishing services; provision of online non-downloadable electronic publications in the field of marketing

International Class(es): 041 - Primary Class

U.S Class(es): 100, 101, 107

Class Status: ACTIVE

Basis: 1(b) 44(d)

For: Design research in the field of graphic arts; graphic design illustrating services; industrial and commercial art design services; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; computer services, namely, designing and implementing network web sites, software applications and information technology computer network systems for others; website design services; creation, editing and updating of website content; software development and maintenance of computer programs and mobile applications to track consumer usage and preferences on websites; design of publicity and advertising materials; computer services, namely, designing and implementing banner advertisements on internet sites for others; graphic design services

International Class(es): 042 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(b) 44(d)

Basis Information (Case Level)

Filed Use: No	Currently Use: No	Amended Use: No
Filed ITU: Yes	Currently ITU: Yes	Amended ITU: No
Filed 44D: Yes	Currently 44D: Yes	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: SMARTFOCUS UK LTD
Owner Address: LYNTON HOUSE 7-12
TAVISTOCK SQUARE
LONDON WC1H 9LT
UNITED KINGDOM
Legal Entity Type: CORPORATION
State or Country Where Organized: UNITED KINGDOM

Attorney/Correspondence Information

Attorney of Record
Attorney Name: David M. Kelly
Attorney Primary Email Address: docketing@finnegan.com
Docket Number: 04857.0004
Attorney Email Authorized: Yes
Correspondent
Correspondent Name/Address: David M. Kelly
Kelly IP, LLP
1330 Connecticut Avenue, NW, Suite 300
WASHINGTON, DISTRICT OF COLUMBIA 20036
UNITED STATES
Phone: 202.808.3571
Fax: 202.354.5232
Correspondent e-mail: docketing@kelly-ip.com david.kelly@kelly-ip.com
Correspondent e-mail Authorized: Yes
Domestic Representative
Domestic Representative Name: David M. Kelly
Phone: 202.408.4000
Fax: 202.408.4400
Domestic Representative e-mail: docketing@finnegan.com
Domestic Representative e-mail Authorized: Yes

Prosecution History

Date	Description	Proceeding Number
Mar. 03, 2014	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Mar. 03, 2014	LETTER OF SUSPENSION E-MAILED	6332
Mar. 03, 2014	SUSPENSION LETTER WRITTEN	72156
Feb. 03, 2014	TEAS/EMAIL CORRESPONDENCE ENTERED	88889

Feb. 03, 2014	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Feb. 03, 2014	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Nov. 20, 2013	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Aug. 02, 2013	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Aug. 02, 2013	NON-FINAL ACTION E-MAILED	6325
Aug. 02, 2013	NON-FINAL ACTION WRITTEN	72156
Jul. 22, 2013	ASSIGNED TO EXAMINER	72156
May 28, 2013	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Apr. 16, 2013	NOTICE OF PSEUDO MARK E-MAILED	
Apr. 15, 2013	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Apr. 11, 2013	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information	
TM Attorney: BEVERLY, JOSETTE MICHE	Law Office Assigned: LAW OFFICE 115
File Location	
Current Location: TMO LAW OFFICE 115 - EXAMINING ATTORNEY ASSIGNED	Date in Location: Mar. 03, 2014

Assignment Abstract Of Title Information

Summary

Total Assignments: 1

Applicant: Emailvision (UK) Limited

Assignment 1 of 1

Conveyance: CHANGE OF NAME	
Reel/Frame: <u>5151/0863</u>	Pages: 3
Date Recorded: Nov. 11, 2013	
Supporting Documents: <u>assignment-tm-5151-0863.pdf</u>	
Assignor	
Name: <u>EMAILVISION (UK) LIMITED</u>	Execution Date: Oct. 08, 2013
Legal Entity Type: CORPORATION	State or Country Where Organized: UNITED KINGDOM
Assignee	
Name: <u>SMARTFOCUS UK LTD</u>	State or Country Where Organized: UNITED KINGDOM
Legal Entity Type: CORPORATION	
Address: LYNTON HOUSE 7-12 TAVISTOCK SQUARE LONDON, UNITED KINGDOM WC1H 9LT	
Correspondent	
Correspondent Name: DAVID M.KELLY	
Correspondent Address: 1330 CONNECTICUT AVENUE, NW, SUITE 300 WASHINGTON, DC 20036	
Domestic Representative	
Domestic Representative Name: DAVID M. KELLY	
Domestic Representative Address: 1330 CONNECTICUT AVENUE, NW, SUITE 300 WASHINGTON, DC 20036	